

Serial No.: 10/619,921
Confirmation No.: 7148
Applicant: John Conan Doyle II
Atty. Ref.: 13544.0002.NPUS00

IN RESPONSE TO THE OFFICE ACTION:

REMARKS REGARDING SPECIFICATION AMENDMENTS:

In the specification, the paragraphs [0042] and [0045] have been amended to correct minor editorial problems. Paragraph [0040] has been amended to more fully identify the material incorporated by reference as U.S. Patent No. 6,591,221.

REMARKS REGARDING CLAIM AMENDMENTS:

Claims 1–14, 16–28, and 30–33 remain in this application. Claims 15, 29, and 34–46 have been cancelled. Claims 1 and 20 have been amended to incorporate the limitations in claims 15 and 29 respectfully. Support for the above amendments can be found in the original specification, claims, and drawing as no new matter has been added. Applicant respectfully submits that the claims as amended are clearly distinct and patentable over the prior art of record and therefore respectfully request that they be allowed.

OBJECTIONS TO SPECIFICATION:

Paragraphs [0042] and [0045] have been amended to correct the informalities identified by the Examiner. Applicant respectfully submits that the objection to the incorporation by reference of material in paragraph [0040] be withdrawn as paragraph [0040] has been amended to more fully identify the incorporation material as U.S. Patent No. 6,591,221. Applicant respectfully directs the Examiner to paragraph [0072] as providing proper antecedent basis for the claimed subject matter “the processor selects an area on the animal to apply a medical product or to determine subcutaneous fat with an ultrasound transducer.”

In light of the above amendments and remarks, Applicant respectfully requests that the Examiner reconsider and withdraw the objections to the specification.

FIRST REJECTION UNDER 35 U.S.C. § 102(b):

Claims 1–4, 7–13, 20–24, 26–28, and 31 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,483,441 to Scofield (“Scofield”). Applicant requests that the Examiner reconsider and withdraw the above rejections in view of the following remarks.

Independent claims 1 and 20 are not disclosed, taught, or suggested by Scofield. Independent claim 1 requires “a first ultrasound transducer arranged substantially vertical to the animal to determine an approximate height of a second portion of the animal.” Likewise, independent claim 20 requires “means for determining an approximate height of a first portion of the animal.” As indicated by Examiner’s acknowledgement that cancelled claims 15 and 29 would be allowable if rewritten in independent form, Scofield does not disclose, teach, or suggest either such limitation. For at least these reasons, Applicant respectfully requests that the Examiner reconsider and withdraw the § 102(b) rejection of independent claims 1 and 20.

Claims 2–4, 7–13, 21–24, 26–28, and 31 depend from claims 1 and 20 and thus, incorporate each limitation therein. Therefore, claims 2–4, 7–13, 21–24, 26–28, and 31 are allowable for at least the same reason as independent claims 1 and 20. Applicant therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claims 2–4, 7–13, 21–24, 26–28, and 31.

SECOND REJECTION UNDER 35 U.S.C. § 102(b):

Claims 1–3, 7–13, 20–23, and 25 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 4,939,574 to Petersen et al. (“Petersen”). Applicant requests that the Examiner reconsider and withdraw the above rejections in view of the following remarks.

Independent claims 1 and 20 are not disclosed, taught, or suggested by Petersen. Independent claim 1 requires “a first ultrasound transducer arranged substantially vertical to the animal to determine an approximate height of a second portion of the animal.” Likewise, independent claim 20 requires “means for determining an approximate height of a first portion of the animal.” As indicated by Examiner’s acknowledgement that cancelled claims 15 and 29 would have been allowable if rewritten in independent form, Petersen does not disclose, teach, or

suggest either such limitation. For at least these reasons, Applicant respectfully requests that the Examiner reconsider and withdraw the § 102(b) rejection of independent claims 1 and 20.

Claims 2–3, 7–13, 21–23, and 25 depend from claims 1 and 20 and thus, incorporate each limitation therein. Therefore, claims 2–3, 7–13, 21–23, and 25 are allowable for at least the same reason as independent claims 1 and 20. Applicant therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claims 2–3, 7–13, 21–23, and 25.

FIRST REJECTION UNDER 35 U.S.C. § 103(a):

Claim 5 and 6 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petersen in view of U.S. Patent 6,639,352 to Eom (“Eom”). Applicant requests that the Examiner reconsider and withdraw the above rejections in view of the following remarks.

The fundamental basis for an obviousness determination under 35 U.S.C. §103(a) was set forth by the Supreme Court in *Graham v. John Deere Co.*, 383 US 1; 148 U.S.P.Q. 459 (1966). In subsequent cases involving a determination of obviousness under 35 U.S.C. §103, the Federal Circuit has noted that the following basic tenets of patent law must be adhered to: 1) the claimed invention must be considered as a whole; 2) the references must be considered as a whole and must suggest the desirability and, thus, the obviousness of making the combination; 3) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and 4) reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 U.S.P.Q. 182, 187, n.5 (Fed. Cir. 1986). All of the claim limitations must be taught in order to establish obviousness. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As discussed above, independent claim 1 is not disclosed, taught, or suggested by Petersen. Eom also does not disclose, teach, or suggest “a first ultrasound transducer arranged substantially vertical to the animal to determine an approximate height of a second portion of the animal.” Claims 5 and 6 each depends from independent claim 1 and thus necessarily incorporates each limitation therein. Therefore, claims 5 and 6 are allowable for at least the same reasons as independent claim 1. Applicant therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claims 5 and 6.

Serial No.: 10/619,921
Confirmation No.: 7148
Applicant: John Conan Doyle II
Atty. Ref.: 13544.0002.NPUS00

SECOND REJECTION UNDER 35 U.S.C. § 103(a):

Claim 14 and 33 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petersen in view of U.S. Patent 4,785,817 to Stouffer (“Stouffer”). Applicant requests that the Examiner reconsider and withdraw the above rejections in view of the following remarks.

The applicable case law for a rejection under 35 USC §103(a) has been discussed above in the response to the first rejection under 35 USC §103(a). In the interests of brevity, Applicant requests the Examiner to note the above section and consider that material incorporated herein by reference.

As discussed above, independent claims 1 and 20 are not disclosed, taught, or suggested by Petersen. Stouffer also does not disclose, teach, or suggest the use of an ultrasound transducer or any other means to determine the approximate height of a portion of an animal. Claims 14 and 33 depend from independent claims 1 and 20, and thus necessarily incorporate each limitation therein. Therefore, claims 14 and 33 are allowable for at least the same reasons as independent claims 1 and 20. Applicant therefore respectfully requests that the Examiner also reconsider and withdraw the rejection of claims 14 and 33.

For at least the reasons presented above, Applicant respectfully requests that the rejection of claims 1–14, 16–28, and 30–41 be reconsidered and withdrawn and that the Examiner indicate the allowance of the claims in the next paper from the Office.

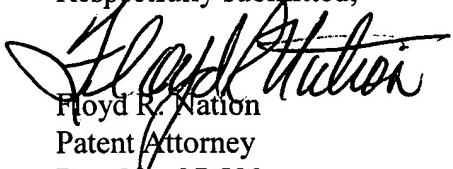
ALLOWABLE SUBJECT MATTER

The Examiner indicated that claims 15–19, 29, 30 and 32 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the Examiner’s acknowledgement of allowable subject matter. However, claims 16–19, 30, and 32 ultimately depend from amended independent claims 1 and 20. Additionally, claims 15 and 29 have been cancelled. Claims 1 and 20 are allowable for the reasons set forth above. Thus, claims 16–19, 30, and 32 are also in condition for allowance as presented. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejections to claims 16–19, 30, and 32.

Serial No.: 10/619,921
Confirmation No.: 7148
Applicant: John Conan Doyle II
Atty. Ref.: 13544.0002.NPUS00

Applicant invites the Examiner to contact the undersigned attorney by telephone to discuss any issues or questions presented by this paper.

Respectfully submitted,



Floyd R. Nation

Patent Attorney

Reg. No. 27,580

Tel. (713) 787-1661

Date: MARCH 28, 2005